REMARKS

Claims 1 - 24 are pending in the application. Claims 1 - 24 have been rejected. Claims 1, 9 and 17 have been amended.

Claims 1, 5, 6, 9, 13, 14, 17 and 20 stand rejected under 35 U.S.C. § 112, first paragraph. This rejection is traversed. However, to expedite prosecution, Applicants have amended some of the rejected claims in an attempt to address this rejection. For example, claims 1, 9 and 17 have been amended to specify a "system model basis". Claims 5 and 13 stand rejected based upon the term "system model identifier". It is respectfully submitted that those skilled in the art would appreciate based upon the specification and claims that a "system model identifier" is an identifier for a system model. Claims 6, 14 and 20 stand rejected based upon the term "system manufacture date". It is respectfully submitted that those skilled in the art would appreciate based upon the specification and claims that a "system manufacture date" is the date on which the manufacture of a system is completed.

Claims 1, 8, 9, 16, 17 and 24 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Wu et al., U.S. Patent Publication No. 20040083213 (Wu). Claims 2 – 7, 10 – 15, and 18 – 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Collins, et al, U.S. Patent Publication No. 20040243998 (Collins) in view of Markham, U.S. Patent Publication No. 20030158795 (Markham).

The present invention generally relates to a knowledge management system which includes the ability to flag predetermined systems that have a known exception (i.e., an excursion) and render a solution based upon the known excursion.

More specifically, the present invention, as set forth by independent claim 1, relates to a method for identifying excursions to general solutions provided by a solution network. The method includes identifying excursions to a general solution on a system model basis, saving the excursions within the solution network on a model system basis, and when accessing the solution network, searching the solution network to determine whether an excursion solution exists.

The present invention, as set forth by independent claim 9, relates to an apparatus for identifying excursions to general solutions provided by a solution network. The apparatus includes means for identifying excursions to a general solution on a system model basis, means for saving the excursions within the solution network on a system model basis, and means for searching the solution network to determine whether an excursion solution exists when accessing the solution network.

The present invention, as set forth by independent claim 17, relates to a solution network which includes a knowledge repository, an excursion identifying module, and a search module. The knowledge repository stores information regarding general solutions relating to issues and information relating to excursions to general solutions. The excursions are searchable on a system model basis. The excursion identifying module identifies excursions to the general solutions on a system basis. The search module searches the solution network to determine whether an excursion solution exists when accessing the solution network.

Wu discloses solution searching. More specifically, Wu provides for solution searching during a session with a user. The user creates a search request for a solution. A data store provides refinement criteria that are displayed to the user. The refinement criteria are associated with the search request. The user then selects the refinement criteria. In response, the data store provides solutions that are displayed to the user. The solutions are associated with the search request and the selected refinement criteria. The user selects the solutions. The search request, the selected refinement criteria, and the selected solutions for the session are then stored in the data store.

Collins discloses restoring a software image of a customer information handling system to the same software image the system had when leaving the factory. The customer information handling system enters a re-imaging mode where the system requests a software download server to recreate the software image originally shipped with that particular information handling system. Once the replacement software image is created, the customer information handling system downloads the replacement software image to the media drive of the customer information handling system.

Markham relates to quality management and manufacturing with labels and smart tags in event based product manufacturing. Markham discloses a process control system which includes sensors which generate an alarm in response to an event. (See e.g., Markham ¶8) Markham sets forth that events may affect productivity of a process and that adverse productivity events are events that adversely affect the productivity of a process. (See e.g., Markham ¶42.)

Wu, Collins and Markham, taken alone or in combination, do not teach or suggest a method for identifying excursions to general solutions provided by a solution network much less such a method which includes identifying excursions to a general solution on a system model basis, saving the excursions within the solution network on a system model basis, and when accessing the solution network, searching the solution network to determine whether an excursion solution exists, all as required by claim 1. Accordingly, claim 1 is allowable over Wu, Collins and Markham. Claims 2 - 8 depend from claim 1 and are allowable for at least this reason.

Wu, Collins and Markham, taken alone or in combination, do not teach or suggest an apparatus for identifying excursions to general solutions provided by a solution network much less such an apparatus includes means for identifying excursions to a general solution on a system model basis, means for saving the excursions within the solution network on a system model basis, and means for searching the solution network to determine whether an excursion solution exists when accessing the solution network, all as required by claim9. Accordingly, claim 9 is allowable over Wu, Collins and Markham. Claims 10 - 16 depend from claim 9 and are allowable for at least this reason.

Wu, Collins and Markham, taken alone or in combination, do not teach or suggest a solution network which includes, a knowledge repository and an excursion identifying module, much less such a solution network where the knowledge repository stores information regarding general solutions relating to issues and information relating to excursions to general solutions and the excursions are searchable on a system model basis; the excursion identifying module identifies excursions to the general solutions on a system basis; and the search module searches the solution network to determine whether an excursion solution exists when accessing the solution network, all as required by claim 17. Accordingly, claim 17 is allowable over Wu,

Collins and Markham. Claims 18 - 24 depend from claim 17 and are allowable for at least this reason.

Additionally, applicants respectfully submit that the combination of Wu, Collins and Markham is improper because Wu, Collins and Markham are nonanalogous prior art that have been combined with the benefit of hindsight and because Wu, Collins and Markham fail to provide a suggestion to be combined.

Wu, Collins and Markham are nonanalogous prior art because Wu relates to search operations, Collins relates to restoring a software image to a customer information handling system and Markham relates to event based product manufacturing.

> The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself .... *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d, 1443, 1446 (Fed. Cir. 1992)

Additionally, even if Wu, Collins and Markham are found to be within analogous arts, Wu, Collins and Markham do not provide a suggestion for such a combination.

> The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. Wilson and Hendrix fail to suggest any motivation for, or desirability of, the changes espoused by the Examiner and endorsed by the Board.
>
> Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fritch*, 23 USPQ 2d at 1783-84 (quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988)).

Further, it appears that the rejection of claims 1, 8, 9, 16, 17 and 24 is based on an improper hindsight-based obviousness analysis. In this regard, it must be recognized that hindsight reconstruction of claims based on disparate aspects of the prior art may not be

employed as a valid basis for the rejection of those claims. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 220 USPQ 303, 312-313 (Fed. Cir. 1983); *Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593, 1595-1596 (Fed. Cir. 1987). Furthermore, an obviousness determination requires that the invention *as a whole* would have been obvious to a person having ordinary skill in the art. *Connell v. Sears Roebuck & Co.*, 220 USPQ 193 (Fed. Cir. 1983).

To establish obviousness based on a combination of elements disclosed in the prior art or a modification of the prior art, there must be some motivation, suggestion or teaching of the desirability of making the claimed invention. *See In re Dance*, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). The motivation, suggestion or teaching to modify references may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Whether the Office Action relies on an express or implicit showing of a motivation or suggestion to modify or combine references, it must provide particular findings related thereto. *In re Dembiczak*, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." *Id.* Thus, the Office Action must include particular *factual findings* that support an assertion that a skilled artisan would have modified the express disclosure of Wu, Collins to develop the invention recited by independent claims 1, 9 and 17. *See In re Kotzab*, 55 USPQ2d 1313, 1317. Applicant is unable to discern the requisite factual basis in Wu, Collins or the Office Action.

In this regard, the Office Action appears to have engaged in a hindsight-based obviousness analysis condemned by the Federal Circuit. To prevent a hindsight-based obviousness analysis, the Federal Circuit has clearly established that the relevant inquiry for determining the scope and content of the prior art is whether there is a reason, suggestion, or motivation in the prior art or elsewhere that would have led one or ordinary skill in the art to combine or modify references. *See Ruiz v. A.B. Chance Co.*, 57 USPQ2d 1161, 1167 (Fed. Cir. 2000); *see also In Re Rouffet*, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("[T]he Board must identify specifically ... the reasons one of ordinary skill in the art would have been motivated to select the references and combine them to render the claimed invention obvious."). Applicant can detect, and the Office Action has pointed to, no motivation or suggestion that would prompt someone of ordinary in the art to look to Wu, Collins and Markham in combination for a solution

to the problem addressed by Applicant's invention. Such a determination that there is a suggestion or motivation to modify Wu, Collins and Markham is a factual finding that is prerequisite to an ultimate conclusion of obviousness. *Sibia Neurosciences, Inc. v. Cadus Pharma. Corp.*, 55 USPQ2d 1927, 1931 (Fed. Cir. 2000). Applicant respectfully submits that the Office Action is devoid of such a finding.

Without such a finding, a *prima facie* case of obviousness in rejecting claims 1, 8, 9, 16, 17 and 24 under 35 U.S.C. § 103(a) based on Wu, Collins has not been made. For this further reason, Applicant respectfully submits that claims 1, 8, 9, 16, 17 and 24 are patentably distinguished over Wu, Collins and Markham and Applicant respectfully requests the Examiner to remove the rejections of claims 1, 9 and 17 and the claims depending therefrom.

CONCLUSION

In view of the amendments and remarks set forth herein, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the examiner is requested to telephone the undersigned.

I hereby certify that this correspondence is being sent to the COMMISSIONER FOR PATENTS via the USPTO Central Facsimile on April 26, 2006.

Attorney for Applicant(s) — Date of Signature: 4/26/06

Respectfully submitted,

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